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UBER TECHNOLOGIES, INC.
14 and OTTOMOTTO LLC

15 UNITED STATES DISTRICT COURT
16 NORTHERN DISTRICT OF CALIFORNIA
17 SAN FRANCISCO DIVISION
18

19 WAYMO LLC,
20 Plaintiff,
21 v.
22 UBER TECHNOLOGIES, INC.,
OTTOMOTTO LLC; OTTO TRUCKING LLC,
23 Defendant.
24

Case No. 3:17-cv-00939-WHA

**UBER'S LIST OF OPINIONS FOR
CASE-IN-CHIEF AT TRIAL
PURSUANT TO DOCKET NO. 669
AND 697**

Trial Date: October 10, 2017

Pursuant to the Court's June 21, 2017 Order and June 22, 2017 Notice and Supplement to Order (Dkt. 669 and 697), Uber Technologies, Inc. and Ottomotto LLC ("Uber") submit the following list of trial witnesses, both retained and non-retained, who are expected to give any opinion testimony in Uber's case-in-chief at trial (including those who will also give fact testimony).¹

A. Dr. Paul McManamon

Dr. McManamon is a retained expert witness for Uber. Uber expects to call Dr. McManamon to testify regarding (1) background information about the LiDAR and self-driving vehicle technology at issue in the case; (2) Uber's defenses to Waymo's trade secret misappropriation claims based on non-use, independent development, public knowledge, and/or the readily ascertainable nature of Waymo's asserted trade secrets, including without limitation the asserted trade secrets identified by Waymo in response to Uber's Interrogatory No. 1; (3) the technical value of the asserted trade secrets; (4) the time that it would take a competitor to replicate the asserted trade secrets from public information or to develop the asserted trade secrets without misappropriation; and (5) potential design-arounds. Dr. McManamon is also expected to testify about the '922 and '464 patents, including (1) the state of the art; (2) the level of a person of ordinary skill in the art at the time of filing of the two patents; (3) disclosed embodiments; (4) how a person of ordinary skill would interpret the claim language in view of the intrinsic record; (5) invalidity of the asserted claims; (6) non-infringement of the asserted claims; (7) non-infringing alternatives; and (8) potential design-arounds. Dr. McManamon is also expected to

¹ Pursuant to the Court's June 21, 2017 Order (Dkt. 669), Uber has identified every witness expected to give opinion testimony with as much specificity as is now possible. But, as set forth in Defendants' motion to compel (Dkt. 687), Waymo has refused to respond to interrogatories or produce documents fundamental to Uber's defenses. If and when Waymo fulfills its interrogatory response and document production obligations, Defendants may supplement this list of opinions based on information not currently known to Defendants. Furthermore, as discovery and trial preparation progresses, and before the deadline to disclose experts, Uber reserves its right to modify its roster of opinion witnesses and the testimony they will provide, including adding or dropping witnesses, adding or dropping opinions to be offered, or modifying the distribution of subjects among the witnesses. For example, it may be the case that one expert will testify about most of the topics addressed by Expert Nos. 6-8.

1 respond to any opinions offered by any expert retained by Waymo relating to Waymo's trade
2 secret misappropriation and patent infringement claims.

3 **B. Dr. Michael Lebby**

4 Dr. Lebby is a retained expert witness for Uber. Uber expects to call Dr. Lebby to testify
5 about (1) background information about the electro-optical system technologies and designs at
6 issue in the case; (2) Uber's defenses to Waymo's trade secret misappropriation claims based on
7 non-use, independent development, public knowledge, and/or the readily ascertainable nature of
8 Waymo's asserted trade secrets, including, without limitation, asserted trade secrets identified by
9 Waymo in response to Uber's Interrogatory No. 1; (3) the technical value of the asserted trade
10 secrets; (4) the time that it would take a competitor to replicate the asserted trade secrets from
11 public information or to develop the asserted trade secrets without misappropriation; (5) potential
12 design-arounds; and (6) the contents of the allegedly downloaded files. Dr. Lebby is also
13 expected to testify about the '922, '464, and '936 patents, including (1) the state of the art; (2) the
14 level of a person of ordinary skill in the art at the time of filing of the three patents; (3) disclosed
15 embodiments; (4) how a person of ordinary skill would interpret the claim language in view of
16 the intrinsic record; (5) invalidity of the asserted claims; (6) non-infringement of the asserted
17 claims; (7) non-infringing alternatives; and (8) potential design-arounds. Dr. Lebby is also
18 expected to respond to any opinions offered by any expert retained by Waymo relating to
19 Waymo's trade secret misappropriation and patent infringement claims.

20 **C. Retained Uber Expert No. 3**

21 Uber expects to call Expert No. 3 to testify about (1) background information about the
22 LiDAR, self-driving vehicle technology, and/or electro-optical system technologies and designs
23 at issue in the case; (2) Uber's defenses to Waymo's trade secret misappropriation claims based
24 on non-use, independent development, public knowledge, and/or the readily ascertainable nature
25 of Waymo's asserted trade secrets, including, without limitation, asserted trade secrets identified
26 by Waymo in response to Uber's Interrogatory No. 1; (3) the technical value of the asserted trade
27 secrets; (4) the time that it would take a competitor to replicate the asserted trade secrets from
28 public information or to develop the asserted trade secrets without misappropriation; and

1 (5) potential design-arounds. Expert No. 3 is also expected to testify about the '922, '464, and
2 '936 patents, including (1) the state of the art; (2) the level of a person of ordinary skill in the art
3 at the time of filing of the three patents; (3) disclosed embodiments; (4) how a person of ordinary
4 skill would interpret the claim language in view of the intrinsic record, (5) invalidity of the
5 asserted claims; (6) non-infringement of the asserted claims; (7) non-infringing alternatives; and
6 (8) potential design-arounds. Expert No. 3 is also expected to respond to any opinions offered by
7 any expert retained by Waymo relating to Waymo's trade secret misappropriation and patent
8 infringement claims.

9 **D. Kevin Faulkner**

10 Mr. Faulkner is a digital forensic expert for Uber. Uber expects to call Mr. Faulkner to
11 testify about the investigation by his firm Stroz Friedberg during the course of this litigation into
12 whether any Waymo downloaded material exists on the computer systems of Uber. In addition to
13 fact testimony, Mr. Faulkner is expected to testify about (1) data collection methods and forensic
14 techniques used to search the computer systems of Uber in this case; (2) the results of Stroz
15 Friedberg's investigation during the course of this litigation; (3) the types of files in the alleged
16 Waymo downloaded materials; and (4) the techniques applied by Stroz Friedberg to eliminate
17 "false positives" from the search of the computer systems of Uber. Mr. Faulkner is also expected
18 to respond to any opinions offered by any expert retained by Waymo on these subjects.

19 **E. Retained Uber Expert No. 5**

20 Uber expects to call Expert No. 5 to testify about the investigation of whether any Waymo
21 downloaded material exists on the computer systems of Uber. Expert No. 5 is expected to testify
22 about (1) data collection methods and forensic techniques used to search the computer systems of
23 Uber in this case; (2) the results of the investigation of Uber's computer systems; (3) the types of
24 files in the alleged Waymo downloaded material; and (4) the techniques applied to eliminate
25 "false positives" from the search of the computer systems of Uber. Expert No. 5 is also expected
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1 to respond to any opinions offered by any expert retained by Waymo on these subjects, such as
2 analysis of Google and Waymo networks and logs.²

3 **F. Retained Uber Expert No. 6**

4 Uber expects to call Expert No. 6 to testify about the adequacy of Uber's efforts (1) to
5 ensure that trade secrets and other intellectual property of Waymo was not brought to Uber by
6 incoming employees, and (2) to investigate whether any Waymo downloaded material exists or
7 has been used within Uber. Expert No. 6 is expected to testify about (1) corporate practices and
8 customs (including, without limitation, employment agreements and instructions to employees)
9 for ensuring that trade secrets and other intellectual property of third parties are not brought to a
10 company by incoming employees; (2) Uber's employment agreements restricting employees from
11 bringing or utilizing the trade secrets or other intellectual property of former employers; and (3)
12 the adequacy of Uber's efforts to search its computer systems, interview employees, collect and
13 review documents, submit to inspections of Uber's facilities by Waymo's counsel, and take other
14 measures to locate any Waymo downloaded material at Uber. Expert No. 6 is also expected to
15 respond to any opinions offered by any expert retained by Waymo on these subjects.³

16 **G. Retained Uber Expert No. 7**

17 Uber expects to call Expert No. 7 to testify about relevant Silicon Valley business
18 practices, including practices and/or customs regarding (1) employee exploration of other
19 employment options while at an employer; (2) recruiting of employees by competitors;
20 (3) sharing of information in connection with exploration of employment options and/or
21 recruiting of employees; (4) use of technical knowledge in subsequent employment; (5) employee

23 ² Should the Stroz Friedberg due diligence report and other documents subject to
24 Waymo's motions to compel be produced pursuant to the Court's June 8, 2017 and June 21, 2017
25 Orders (Dkt. 566 and 670), Mr. Faulkner and/or Expert No. 5 are expected to testify about any
data collection methods and forensic techniques used in connection with the due diligence
investigation.

26 ³ Should the Stroz Friedberg due diligence report and other documents subject to
27 Waymo's motions to compel be produced pursuant to the Court's June 8, 2017 and June 21, 2017
28 Orders (Dkt. 566 and 670), Expert No. 6 is expected to testify about the adequacy of Uber's due
diligence efforts to ensure that Waymo trade secrets and other intellectual property would not be
brought to Uber as a result of the Otto acquisition.

1 mobility; and (6) employee side businesses. Expert No. 7 is also expected to respond to any
2 opinions offered by any expert retained by Waymo on these subjects.

3 **H. Retained Uber Expert No. 8**

4 Uber expects to call Expert No. 8 to testify about Uber's acquisition of Ottomotto as it
5 compares to general merger and acquisition practices in technology companies, including
6 (a) intellectual property due diligence, (b) evaluation of potential litigation, and
7 (c) indemnifications provided by parties to acquisitions.

8 **I. Retained Uber Expert No. 9**

9 Uber expects to call Expert No. 9 to testify regarding any damages claimed by Waymo in
10 connection with Waymo's trade secret misappropriation and patent infringement claims. Expert
11 No. 9 is expected to testify regarding (1) the absence of actual damages; (2) the absence of lost
12 profits; (3) a reasonable royalty, if any, for the use of relevant technology; (4) damages in the
13 context of emerging technologies; and (5) whether Waymo's damages claim is speculative.
14 Expert No. 9 is also expected to testify regarding whether the patented features drive demand for
15 Waymo's products. Expert No. 9 is also expected to respond to any opinions offered by any
16 expert retained by Waymo on the subject of damages.

17 **J. James Haslim**

18 Mr. Haslim is a senior engineering manager at Uber. In addition to fact testimony, Mr.
19 Haslim is expected to testify about public knowledge and/or engineering knowledge of general
20 principles and approaches in LiDAR and related fields pertaining to features in Uber's LiDARs
21 that Waymo claims were based on misappropriated trade secrets.

22 **K. Scott Boehmke**

23 Mr. Boehmke is an engineering manager at Uber. In addition to fact testimony, Mr.
24 Boehmke is expected to testify about public knowledge and/or engineering knowledge of general
25 principles and approaches in LiDAR and related fields pertaining to features in Uber's LiDARs
26 that Waymo claims were based on misappropriated trade secrets.

1 **L. Gaetan Pennecot**

2 Mr. Pennecot is an engineer at Uber. In addition to fact testimony, Mr. Pennecot is
3 expected to testify about public knowledge and/or engineering knowledge of general principles
4 and approaches in LiDAR and related fields pertaining to features in Uber's LiDARs that Waymo
5 claims were based on misappropriated trade secrets.

6 **M. Daniel Gruver**

7 Mr. Gruver is a Senior Program Manager at Uber. In addition to fact testimony, Mr.
8 Gruver is expected to testify about public knowledge and/or engineering knowledge of general
9 principles and approaches in LiDAR and related fields pertaining to features in Uber's LiDARs
10 that Waymo claims were based on misappropriated trade secrets.

11 **N. Dr. John Bares**

12 Dr. Bares is an Operations Director at Uber. In addition to fact testimony, Dr. Bares is
13 expected to testify about public knowledge and/or engineering knowledge of general principles
14 and approaches in LiDAR and related fields pertaining to features in Uber's LiDARs that Waymo
15 claims were based on misappropriated trade secrets.

16 **O. Florin Ignatescu**

17 Mr. Ignatescu is an engineer at Uber. In addition to fact testimony, Mr. Ignatescu is
18 expected to testify about public knowledge and/or engineering knowledge of general principles
19 and approaches in LiDAR and related fields pertaining to features in Uber's LiDARs that Waymo
20 claims were based on misappropriated trade secrets.

21 **P. Asheem Linaval**

22 Mr. Linaval is an engineer at Uber. In addition to fact testimony, Mr. Linaval is expected
23 to testify about the types of files and file names routinely created by Altium, LT Spice, and
24 SolidWorks software, and why hash or file name matches do not establish that such files came
25 from Waymo.

26 **Q. Eric Meyhofer**

27 Mr. Meyhofer is Head of the Advanced Technologies Group at Uber. In addition to fact
28 testimony, Mr. Meyhofer is expected to testify about public knowledge and/or engineering

1 knowledge of general principles and approaches in LiDAR and related fields pertaining to
2 features in Uber's LiDARs that Waymo claims were based on misappropriated trade secrets.

3 **R. Witnesses from Velodyne or other Third-Party LiDAR Suppliers**

4 Witnesses from Velodyne or other third-party LiDAR suppliers may testify about public
5 knowledge and/or engineering knowledge of general principles and approaches in LiDAR and
6 related fields pertaining to LiDAR features of relevance to this case.

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9 Dated: June 29, 2017

MORRISON & FOERSTER LLP

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11 By: /s/ Arturo J. González
ARTURO J. GONZÁLEZ

12 Attorneys for Defendants
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